

REMARKS

With the entry of the amendments above, claims 1-6, 16, 17, 18, 20-23, and 32-38 are pending in this application. Claims 7-15 were previously canceled and claim 19 is canceled in this amendment. Claims 17-32 were subject to a restriction requirement and were withdrawn from consideration. However, as claims 1-6 and 16 were found allowable, method claims 17-23 and 32, which depend directly or indirectly from an allowed product claim, were rejoined with claims 1-6 and 16 as permitted by MPEP 821.04. Claims 24-31, drawn to a non-elected invention, are now canceled. Claims 33-38 are newly presented here.

Claim Amendments

Applicants thank the Examiner for allowance of claims 1-6 and 16, and the rejoinder of claims 17-23 and 32. Claims 1, 3, and 5 have been amended to remove the possibility of “a single bond” for the B moiety. Claim 16 has been amended to recite “A compound of claim 1” for consistency with claims 17 and 22. Claims 17, 20, 21, 22, and 32 are currently amended, and claims 33-38 are newly presented. Newly presented claims 33-36 are method claims dependent from allowed product claims. Newly presented claims 37-38 are product claims dependent from allowed product claims. These amendments do not introduce new matter. No fees are believed to be due by the presentation of these amendments; fees for presentation of the six new claims 33-38 are offset by fees already paid for the nine claims canceled herein (claims 19 and 24-31).

Note regarding Certificate of Mailing on previously filed Amendment and transmittal

The Amendment and Response Under 37 C.F.R. § 111 mailed on May 12, 2003 contained a Certificate of Mailing By “First Class Mail” which was correctly dated and signed on May 12, 2003. However, on the accompanying transmittal form, the Certificate of Mailing By “First Class Mail” contained an incorrect date of June 26, 2002. As the Amendment itself was the only paper required in response to the Office Action of February 12, 2003 (Paper No.

12), and that Amendment contained an accurate Certificate of Mailing, it is believed that the incorrectly dated Certificate of Mailing on the transmittal that accompanied the Amendment does not affect the timeliness of filing of the Amendment under 37 C.F.R. § 1.8(a)(1).

However, should the Office determine that the Certificate of Mailing on the Amendment itself is not entitled to the provisions of 37 C.F.R. § 1.8(a)(1) due to the incorrect date on its accompanying transmittal, Applicants note the language in the Amendment which petitions for any required relief and which authorizes charges to the Deposit Account for that purpose (see page 9 of the Amendment mailed May 12, 2003. As the Office received the amendment on May 16, 2003, Applicants respectfully request that a petition for a one-month extension of time for the filing of that Amendment be granted, should the Office determine that the Certificate of Mailing on the Amendment is not entitled to the provisions of 37 C.F.R. § 1.8(a)(1).

Claim rejections

Claims 17, 19, 21, 22, and 32 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention. Claims 18, 20, and 23 were also rejected as indefinite for dependence on a claim regarded as indefinite.

Claim 17 is herein amended to recite “cancer” instead of “indication.” This amendment is supported by originally filed claim 19, which recites cancer as the indication to be treated, and is also supported at page 25, line 23 of the current specification. The claim has also been amended to make it dependent from claim 3 instead of claim 1. Finally, the language “a compound of claim 3” is used to clarify that the compounds of claim 3 are the compounds intended to be administered in claim 17. Claim 20 originally depended from claim 19, which is now canceled in this amendment; accordingly, claim 20 has been amended to depend from claim 17 instead. This is believed to obviate the rejection under 35 U.S.C. § 112, second paragraph for claims 17, and claims 18 and 20 dependent thereon, and removal of this rejection is respectfully requested.

Claim 19 is canceled in this response, and accordingly the rejection is moot with respect to this claim.

Claim 21 is amended in this response to recite a method of treating a disease in an individual instead of treating an "indication," and has been amended to depend from claim 3. The language "problems associated with tissue grafts and organ transplants" has been deleted from the claim. Support for replacing "indication" with "disease" is found at page 25, line 20 of the specification. This is believed to obviate the rejection under 35 U.S.C. § 112, second paragraph for claim 21, and removal of this rejection is respectfully requested.

Claim 22 has been amended to make it dependent from claim 3 instead of claim 1. Again, the language "a compound of claim 3" is used to clarify that the compounds of claim 3 are the compounds intended to be administered in claim 22. This is believed to obviate the rejection under 35 U.S.C. § 112, second paragraph for claim 22, and claim 23 dependent thereon, and removal of this rejection is respectfully requested.

Claim 32 has been amended to recite "cancer" instead of "indication." This amendment is supported by originally filed claim 19, which recites cancer as the indication to be treated, and is also supported at page 25, line 23 of the current specification. This is believed to obviate the rejection under 35 U.S.C. § 112, second paragraph for claim 32, and removal of this rejection is respectfully requested.

New claims 33-34 claim methods of treating cancer by using the compounds of claim 1. These claims are supported at page 5, line 21 to page 6, line 1 (compounds) and page 14, lines 24-28 (treating cancer, including breast cancer) of the current specification. New claims 35-36 claim methods of treating cancer by using the compounds of claim 4. These claims are supported at page 7, lines 10-14 (compounds) and page 14, lines 24-28 (treating cancer, including breast cancer) of the current specification. Applicants submit that these claims are in condition for allowance, as they depend from allowed product claims.

New claim 37 claims a compound of claim 3 with a pharmaceutically acceptable excipient. This claim is supported by original claim 3 and at page 31, line 5, to page 32, line 15

(see, e.g., page 31, line 17). New claim 38 claims a compound of claim 4 with a pharmaceutically acceptable excipient. This claim is supported by original claim 4 and at page 31, line 5, to page 32, line 15 (see, e.g., page 31, line 17). Applicants submit that these claims are in condition for allowance, as they depend from allowed product claims.



CONCLUSION

Applicants submit that the issues raised in the Office Action mailed July 24, 2003 (Rejections under 35 U.S.C. § 112, second paragraph) have been addressed. Reconsideration and allowance of the pending claims is earnestly solicited. Should the Examiner have any concerns that may be addressed by a telephone conference, he is invited to call the undersigned agent at 1-650-813-5715.

In the event that the Patent Office determines that an extension, excess claim fees, and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 376462000400. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: January 23, 2004

By: _____

Robert K. Cerpa
Registration No. 39,933

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5715
Facsimile: (650) 494-0792

RECEIVED
FEB 03 2004
TECH CENTER 1000